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Attorney Docket No. 14991.01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

IN THE APPLICATION OF:

APPLICANT : ROBERT W. JONES
APPL. NO. : 10/751,510 ART UNIT: 1723
FILED : January 6, 2004 EXAMINER: J. DRODGE
FOR : GUTTER FOAM FILTER

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TRANSMITTAL OF BRIEF ON APPEAL

Sir:

Transmitted herewith are:

1. Appeal Brief (11 pages)
2. Appendices (6 pages)
3. Check for \$250.00 (Filing of Brief)

Any required fees may be charged to Deposit Account No. 12-1662 of Richard C. Litman.

Respectfully submitted,

Handwritten signature of Charles K. Friedman.

Charles K. Friedman
Registration No. 39,195



Attorney Docket No. 14991.01

Confirmation No. 3347

Customer No. 37833

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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BRIEF ON APPEAL

Sir:

This is a Brief in support of Applicant's Appeal from the
Examiner's decision rejecting Claims 12-20.

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I. REAL PARTY IN INTEREST

Robert W. Jones is the real party in interest. This application has not been assigned.

II. RELATED APPEALS AND INTERFERENCES

No related appeals or interferences are known to appellant.

III. STATUS OF CLAIMS

This is a Utility Patent Application. The claims on appeal are Claims 12-20. An Appendix containing a copy of these appealed claims is attached.

Claims 1-11 have been cancelled. Claims 12, 13, 15-17, 19, and 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dugan in view of Homa. Claim 14 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Dugan in view of Homa and further in view of Etani. Claim 18 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Dugan in view of Homa and further in view of Hunt.

IV. STATUS OF AMENDMENTS

The indicated allowability was withdrawn by the Examiner in the July 10, 2006 Office Action. Applicant made the substantial effort to swear behind one of the references, only to have another reference applied in its place. Because of this piecemeal prosecution, the Examiner was obligated to make the Office Action, from which Applicant now appeals, non-final. Therefore, all amendments have been entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The invention, as best seen in Figure 2 is a combination filter insert and rain gutter. The elongated filter insert 24 has a cross section in the form of a truncated right triangle (as disclosed at page 7, lines 14-15 of the specification) and is made of open cell foam porous material (page 9, line 21). The filter insert has a generally horizontal upper side 32 with front and rear edges, a generally vertical rear side 26 perpendicular to the upper side and having an upper edge coincident with the rear edge of the upper side and a lower edge. The insert has a generally flat, angled side 28 extending between the front edge of the upper side and a lower forward edge proximate to and

forward of the lower edge of the rear side 26 and rearward of the front edge of the upper side 32. The insert 24 has a lower side 30 parallel with the upper side 32 and extending forward from the lower edge of the rear side 26 to the lower forward edge, the lower side 30 of the filter insert 24 being formed by the truncation of the filter insert between the rear side 26 and the angled side 28 (page 7, lines 17-19).

As seen in the figures, the filter insert 24 is inserted into a rain gutter 12 having a back wall 14, a bottom wall 16, and a front wall 18. The front wall 18 has an upper lip 20. An upper opening is defined between the back wall and the front wall upper lip.

As discussed in the paragraph beginning at page 7, line 20, the filter insert is inserted into the rain gutter such that the insert upper side spans the gutter upper opening between the back wall and the upper lip of the front wall. The rear side of the insert is positioned against and coextensive with the gutter back wall, and the insert lower is positioned against the gutter bottom wall. The angled side extends between the lower side of the insert at the lower forward edge to the gutter front wall upper lip, wherein the angled side of the insert faces the front and bottom walls of the gutter. A void having a substantially triangular-shaped cross section is defined between the angled side of the insert, the front wall of the gutter, and the bottom

wall of the gutter, whereby liquid may enter the gutter upper opening and travel through the filter insert into the void, for flow to a gutter liquid outlet while leaves and other debris are trapped on the upper side of the filter insert.

As recited in Claim 14 and discussed at page 9, lines 19-20 of the specification, the open cell porous foam material is flexible polyether foam. The gutter spikes and the filter fitting below the spikes, as recited in Claim 18, is discussed a page 8, lines 12-18. This feature is also shown in Figure 1.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issues presented for consideration by the Board of Appeals are as follows:

Whether, pursuant to U.S.C. 103(a), Claims 12, 13, 15-17, 19, and 20 are unpatentable over Dugan in view of Homa.

Whether, pursuant to U.S.C. 103(a), Claim 14 is unpatentable over Dugan in view of Homa and further in view of Etani.

Whether, pursuant to U.S.C. 103(a), Claim 18 is unpatentable over Dugan in view of Homa and further in view of Hunt.

VII. ARGUMENTS

A. Claims 12, 13, 15-17, 19, and 20 are patentable under 35 U.S.C. 103(a) over Dugan in view of Homa

The patent to Dugan discloses an open trough filler 2 made of porous polyurethane foam material, for placement in a rain gutter 1. The filler 2 extends from the front to the back of the gutter 1, and a space or open passageway 8 is left between the bottom of the filler 2 and the bottom of the gutter 5. This open passageway configuration may be achieved by the formation of a slot in the lower portion of the filler, or by providing spaced supports along the length of the gutter bottom 5 to support the filler and maintain the open passageway. Regarding the material that Dugan employs for his trough filler, he states that, "An example of a suitable porous solid is one with 95 percent void volume with an average of 10 pores per lineal inch" (Dugan, col. 2, lines 36-38). Dugan does not show: 1) a filter cross-section in the form of a truncated right triangle, 2) a generally flat angled side, 3) a lower side having a lower forward edge proximate to the lower edge of the rear side, and 4) the generally flat angled side extending between the front edge of the upper side to the lower forward edge of the lower side.

There is clearly no teaching or suggestion in the patent to Dugan to modify Dugan to include a filter cross-section in the form of a truncated right triangle with a generally flat angled side extending between the front edge of the upper side to the lower forward edge of the lower side, and a lower side having a lower forward edge proximate to the lower edge of the rear side.

The Examiner relies on the Homa patent to overcome the deficiency of Dugan. Homa teaches a gutter guard with an angled lowermost portion 42 such that the entire gutter guard has the general form of a truncated right triangle. Based on this teaching, the Examiner concludes that it would have been obvious to manufacture the filter of Dugan according to Homa to achieve the truncated right triangle. This combination does not meet the instant invention in that there is no lower side having a lower forward edge proximate to the lower edge of the rear side.

Additionally, the combination is based on impermissible hindsight. Applicant first notes that obviousness cannot be shown by combining the teachings of the prior art unless there is some teaching or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984); *In re Geiger*, 815 F.2d at 688, 2 USPQ2d at 1278 (Fed. Cir. 1987).

Further, the Federal Circuit in *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed.Cir. 1999) deprecated rejections based

upon "a hindsight-based obviousness analysis" and emphasized that what is required is a "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." The Court said that "the showing must be clear and particular" and that broad conclusory statements regarding the teaching of multiple references and "a mere discussion of the ways that the multiple prior art references can be combined to read on the claimed invention" is inadequate. Absent an explicit suggestion or teaching of the combination in the prior art references, there must be "specific...findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis."

The requirement of motivation is not shown in the combination of Dugan and Homa. The Federal Circuit has stated that this critical element must be shown. *In re Rouffet*, 47 USPQ2d 1453 (Fed. Cir. 1998) at 1457-58.

As this court has stated, "virtually all [inventions] are combinations of old elements." (*citations omitted*). ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to

use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensoronics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. (*Emphasis added*).

See also *In re Sang Su Lee*, No. 00-1158 (Fed. Cir. January 2002) (error for Board to hold that obviousness rejection may be based on common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference, citing *Dembiczak and Rouffet*, supra); *Teleflex v. Ficosa North America Corp.*, No. 01-1372 (Fed. Cir. June, 2002) (in order to show motivation to combine references from prior art itself or the nature of the problem in order to show obviousness, actual evidence is required; a conclusory assertion is insufficient).

B. Claim 14 is patentable under 35 U.S.C. 103(a) over Dugan in view of Homa and further in view of Etani

The Etani reference does not overcome the deficiencies of the Dugan/Homa combination, specifically that the combination is inadequate and based on impermissible hindsight.

Additionally, the Etani reference further emphasizes that the Examiner's case is built on impermissible hindsight. Etani is cited because of its teaching of the type of foam. It is noted that Homa teaches a plastic mesh material. It appears that the Examiner is picking and choosing specific features from each of the secondary references to use in the primary reference. It is impermissible hindsight to use the claim as a frame and the prior art references as a mosaic to piece together a facsimile of the invention. *W.L. Gore & Associates v. Garlock, Inc.*, 220 USPQ 303, 312 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

The Examiner ignores the fact that the guard of Homa is made of plastic mesh because it does not follow Applicant's blueprint. Applicant's own disclosure cannot appropriately be used as a blueprint to meet the instant claim. See *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 5 USPQ 2d 1434 (Fed. Cir. 1988).

C. Claim 18 is patentable under 35 U.S.C. 103(a) over Dugan in view of Homa and further in view of Hunt

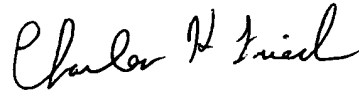
Again, Applicant notes that the Examiner has crafted a rejection and combined a prior art element without any motivation other than the sole purpose of meeting the claim.

IX. CONCLUSION

In view of the foregoing arguments, Appellant respectfully requests the Board to reverse the rejection of the claims as set forth in the Office Action dated July 10, 2006.

The fee for filing the brief in support of the appeal is attached.

Respectfully submitted,



Charles K. Friedman
Registration No. 39,195
LITMAN LAW OFFICES, LTD.
P.O. Box 15035
Arlington, VA 22215
(703) 486-1000

APPENDICES

Claims Appendix

Claim 12. A combination filter insert and rain gutter comprising:

an elongated filter insert having a cross section in the form of a truncated right triangle and made of open cell foam porous material, said filter insert having a generally horizontal upper side with front and rear edges, a generally vertical rear side perpendicular to said upper side and having an upper edge coincident with said rear edge of said upper side and a lower edge, a generally flat, angled side extending between the front edge of said upper side to a lower forward edge proximate to and forward of the lower edge of said rear side and rearward of the upper side front edge, a lower side parallel with said upper side and extending forward from said lower edge of said rear side to said lower forward edge, said lower side of said filter insert being formed by the truncation of said filter insert between said rear side and said angled side; and

a rain gutter having a back wall, a bottom wall, and a front wall, said front wall having an upper lip, an upper opening defined between said back wall and said front wall upper lip,

said filter insert being inserted into said rain gutter such that said insert upper side spans said gutter upper opening between said back wall and said upper lip of said front wall,

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said rear side of said insert bearing against and coextensive with said gutter back wall, and said insert lower side bearing against said gutter bottom wall, said insert angled side extending between said lower side at said lower forward edge to said gutter front wall upper lip, wherein said angled side of said insert faces said front wall and said bottom wall of said gutter, and wherein a void having a substantially triangular-shaped cross section is defined between said angled side of said insert, said front wall and said bottom wall of said gutter, whereby liquid may enter said gutter upper opening and travel through said filter insert into said void, for flow to a gutter liquid outlet while leaves and other debris are trapped on the upper side of said filter insert.

Claim 13. The combined filter insert and gutter of claim 12, wherein said open cell porous foam material has from about 10 to about 20 cells per square inch.

Claim 14. The combined filter insert and gutter of claim 13, wherein said open cell porous foam material is flexible polyether foam.

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Claim 15. The combined filter insert and gutter of claim 12, wherein said filter insert is about four feet in length.

Claim 16. The combined filter insert and gutter of claim 12, wherein said gutter has an inner lip portion extending inward and downward from said upper lip so as to bear against said upper side of said filter insert.

Claim 17. The combined filter insert and gutter of claim 12, wherein said gutter is mounted on a building structure below the eave of a roof such that rainwater draining from said roof enters said gutter through said filter insert upper side.

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Claim 18. The combined filter insert and gutter of claim 17, further comprising a plurality of spaced gutter spikes extending through said gutter upper lip, across said span formed between said upper lip and said back wall, and through said back wall into said building structure for securing said gutter to said building structure, said filter insert fitting below said gutter spikes.

Claim 19. The combined filter insert and gutter of claim 12, wherein said filter insert is about four feet in length and a plurality of filter inserts are inserted end to end into a length of said gutter so as to extend the full length of said gutter.

Claim 20. The combined filter insert and gutter of claim 19 wherein said filter inserts are easily removed from the gutter for cleaning and are easily reinstalled into the gutter.

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Evidence Appendix

None

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Related Proceedings Appendix

None